

Section III:
AMENDMENT UNDER 37 CFR §1.121 to the
DRAWINGS

No amendments or changes to the Drawings are proposed.

Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Information Disclosure Statement

In the Office Action, it was noted that the documents submitted via a supplemental IDS were not considered. It was stated generally that IDS references must be identified by "identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication". Applicant hereby submits an updated IDS List including all known information regarding these references. These references were cited in related patent applications by USPTO examiners, and thus some information requested by the examiner of the present application may not be known or available to the Applicant. However, in order to meet the duty of disclosure, Applicant submits these items with the relevant identifying information as best known to the Applicant.

Consideration of the references is respectfully requested.

Response to Applicant's Arguments

In the Office Action, the rejections under 35 U.S.C. §112, and the rejections under 35 U.S.C. §103(a) over Barnes were withdrawn. Applicant appreciates reconsideration.

Request for Withdrawal of Finality of Office Action

In the Office Action, new rejections of all claims under 35 U.S.C. §103(a) over newly-cited Miller in view of newly-cited "Uribe-Echebarria Diaz De Mendibil" were made final. Applicant requests withdrawal of the finality of the Office Action because the relied-upon reference "Uribe-Echebarria Diaz De Mendibil" is not properly identified:

- (a) it is not cited with full identification information (patent number, publication number, publication date if non-patent literature, title, etc.) in the reasons for rejection (page 9, item 14 of the Office Action);
- (b) it is not listed in the "Notice of References Cited" (PTO-892); and
- (c) it does not appear in Private PAIR.

Because the examiner is currently on vacation, Applicant contacted the examiner's supervisor in order to request assistance in locating this reference, and Examiner Zhen was also unable to determine more identifying information about the reference.

For these reasons, Applicant is unable to respond to the rejections under 35 U.S.C. §103(a) due to improper citation of references, and requests withdrawal of the finality of the Office Action, and allowance of the claims.

Objections to the Specification

In the Office Action, an objection to the previous amendment was made for introducing new matter with respect to the use of the terms "user enablement of automatic natural language translation" and "electronic document".

By "user enablement" of the automatic translation function, Applicant is referring to a user control to turn off or on (e.g. enable or disable) the automatic function of checking information as it passes through a clipboard for matching a preferred natural language (e.g. "enable highlighting or selecting content to automatically copy selected . . ." in paragraph 0066; " [w]hen all destination points and areas have been designated, the user enables (54) the automatic content transfer function . . ." in paragraph 0071 and Figure 5). An "enablement" is referring to the control being set to the "enabled" condition by the user:

Enablement *n.* The act of enabling, or the state of being enabled; ability.

Source: *Webster's Revised Unabridged Dictionary*. Retrieved December 03, 2007, from Dictionary.com website: <http://dictionary.reference.com/browse/enablement>

Applicant respectfully submits that for these reasons the used of the term "enablement" with respect to a user-control to enable or disable the automatic function of the invention is not new matter.

By "electronic document", Applicant is referring to computer files which represent actual documents, such as word processor files, spreadsheets, contact management files, address book files, calendar files, email messages, and presentation files [paragraphs 0004, 0005, 0007, 0008, 0010, 0011, 0018, 0058, 0078, 0079, 0081, 0082, 0083, 0085]. Applicant has appropriately amended the independent claims to specify this range of file types.

Applicant respectfully requests reconsideration and withdrawal of these objections to the specification.

Double Patenting Rejection

In the Office Action, Claims 1, 5 and 9 were rejected as being broader claims which encompass those presented in co-pending patent application 10/865,347. Applicant submits herewith a terminal disclaimer to overcome these rejections. Reconsideration is respectfully requested.

Rejections under 35 U.S.C. §112, First Paragraph

In the Office Action, Claims 1, 5, and 9 were rejected under 35 U.S.C. §112, first paragraph, regarding recitation of "electronic document" and "user enablement" as detailed in the objections to the specification. Applicant respectfully requests reconsideration in view of the present amendment and in view of the foregoing arguments.

Rejections under 35 U.S.C. §101

In the Office Action, Claims 9 - 14, which are drawn to a system embodiment, were rejected under 35 U.S.C. §101 as set forth in the previous Office Action. Applicant maintains all previous arguments that reasonable interpretation of these claims is not purely software, but that of a system, where "system" is a term used in the art to describe combinations of processors, memory, circuitry and software, not just software only:

"The computer itself is the 'hardware'; the programming necessary to run it is the 'software'; together the hardware and software form the 'computer system.'"
Computer Systems Eng'g, Inc. v. Qantel Corp., 740 F.2d 59, 63 n.3 (1st Cir.1984).

A computer system "... consists of a central processing unit (or 'mainframe') and peripheral equipment."
Greyhound Computer Corp. v. IBM Corp., 559 F.2d 488, 492 (9th Cir. 1977).

A computer system is a "group of devices designed: (a) to receive various forms of data (input); (b) to process the data in accordance with predesignated sets of instructions (programs); and (c) to produce the desired information (output)."

Dreier Co. v. Unitronix Corp., 218 N.J. Super. 260, 527 A.2d 875, 879 (1986).

Applicant has disclosed such computer systems and platforms:

"[0041] The present invention is preferably realized as computer-executable code such as compiled software, scripts, or portable programs, in conjunction with existing application programs, operating systems, and computer hardware. For purposes of completeness, we first present a generalized view in Figures 3 and 4 of typical computer hardware and software which is suitable for realization of our invention. Many variations of these computer platform details may be made without departing from the scope of the invention, as will be readily recognized by those skilled in the art."

Applicant respectfully submits that "software only" cannot be a "system" because software cannot execute itself or perform its functions without being realized "in conjunction with computer hardware".

Applicant respectfully requests reconsideration in view of the present amendment, and withdrawal of these rejections.

Rejections under 35 U.S.C. §103(a)

In the Office Action, Claims 1 - 14 were rejected under 35 U.S.C. §103(a) over Miller in view of "Uribe-Echebarria Diaz De Mendibil". However, insufficient identification information is provided in order for Applicant to locate "Uribe-Echebarria Diaz De Mendibil". For these reasons, Applicant requests withdrawal of the finality of the Office Action and of the rejections.

Applicant also points out that in the rationale for the rejections, there is no mention where in either Miller or "Uribe-Echebarria Diaz De Mendibil" the claimed step, element or limitation is found:

" receiving a user command to enable automatic cutting-and-pasting in a destination first, source second sequence, with user enablement of automatic natural language translation; . . . "

Applicant's claim is a destination-first-source-second process, as indicated by this first step, and as indicated by all of the recitations of "subsequent" throughout the rest of the claim which sets forth a specific sequence of events, steps, and operations.

Miller is not a destination-first-source-second process, but instead is the reverse: source-first-destination second:

" . . . select an item on one computer, copy it to the clipboard (using the standard Copy command available in most applications), then turn to the other computer and paste the item (using the standard Paste command)."
(Miller, first column, third paragraph)

For this reason, Miller fails to teach all of the claim steps, elements and limitations related to designating a destination point *before* selecting the source information to be copied.

Additionally, Miller fails to disclose many other claim elements as the Examiner has recognized in the reasons for rejections:

Examiner in the Office Action:

Miller does not explicitly disclose:

- determining which intercepted information elements are expressed in a natural language not matching a user-specified natural language;
- performing one or more natural language handling actions on information elements which do not match said user specified natural language as defined by one or more natural language handling rules; and
- transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions.

Not Obvious to Modify Miller to Solve Present Problem. Miller is not drawn from analogous art of the present invention, but instead relates to transferring information from one computer type to another, where there is no need or presumption for translating the information from one natural language to a second natural language. Therefore, it would have been unreasonable for one ordinarily skilled in the art at the time the invention was made, who was seeking to solve a problem of cutting-and-pasting information from one user interface to another (within the same computer) which may need translation to look to a synchronization patent which is directed towards transfer of information between two different computer types but which is not directed towards any type of natural language translation.

Skill Level Not Properly Determined. With respect to the determination of obviousness under 35 U.S.C. 103(a), the Examiner, not the Applicant, is a fact finder required to resolve *Graham* inquiries ("Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*., Fed. Reg., Vol. 72, No. 195, October 10, 2007).

According to the Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), it is critical to determining obviousness under 35 U.S.C. §103 to ascertain the level of ordinary skill in the art, whereas this is pivotal in the language and standard set forth in the law at §103.

In the Office Action, the Applicant has not been notified what was considered to be the level of ordinary skill in the art. It is not clear if any of the criteria to be considered in determining the level of ordinary skill in the art under the third factual inquiry of *Graham v. John Deere*, as set forth in *Environmental Designs, Ltd. v. Union Oil*, 713 F.2d 693, 696, 218

USPQ 865, 868 (Fed. Cir. 1983) and in *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 449-450, 230 USPQ 416, 420 (Fed. Cir. 1986) were considered, such as:

- (1) the educational level of the inventor;
- (2) the type of problems encountered in the art;
- (3) the prior art solutions to those problems;
- (4) the rapidity with which innovations are made by others, not including the inventor;
- (5) the sophistication of the technology; and
- (6) the educational level of active workers in the field not including the inventor.

Applicant respectfully submits that the holding of obviousness is improper without this factual determination by the Examiner, and requests withdrawal of the rejections.

For these reasons, Applicant respectfully submits that Miller in view of any other art does not render Applicant's claims obvious. Applicant requests allowance of Claims 1 - 14.

Respectfully,

/ Robert Frantz /

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